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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,901	10/31/2001	Werner Lindemann	112740-350	2923

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EXAMINER

AILES, BENJAMIN A

ART UNIT PAPER NUMBER

2142

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/682,901

Applicant(s)

LINDEMANN ET AL.

Examiner

Benjamin A. Ailes

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-15 remain pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8 September 2005 has been entered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1, 12 is rejected under 35 U.S.C. 102(a) as being anticipated by Bhatia et al. (US 6,118,768), hereinafter referred to as Bhatia.

5. Regarding claim 1, Bhatia discloses a method for setting up a connection via an IP-oriented network, the method comprising the steps of:

connecting a device, from which the connection originates, to a local computer network (col. 11, ll. 59-60, Bhatia discloses a user workstation being connected to a local area network.);

connecting the local computer network via a router device to a communications network (see figure 2A, ISDN LAN modem connected to a remote network);

connecting the communications network via a plurality of conversion devices to the IP-oriented network (see figure 2A);

selecting one of the conversion devices by said device (col. 12, lines 2-5, a user connects to their own ISP through the LAN modem), via a selection unit implemented in the router device, using information transferred by the device (col. 12, lines 2-5, a user connects to their own ISP through the LAN modem), wherein the information identifies the selected one of the conversion devices (col. 12, lines 2-5, user's login provides the information necessary to connect to the appropriate ISP); and

setting up a communications link to the select conversion device via the communications network (col. 12, lines 2-5, a user logs onto the LAN and establishes a connection to their ISP).

6. Claim 12 contains similar subject matter and is rejected under the same rationale as claim 1.

7. Regarding claim 2, in accordance with claim 1, Bhatia discloses the method for setting up a connection via an IP-oriented network, wherein the selected conversion device is a default conversion device, a communications link being set up via the default conversion device in cases where no information to the contrary is received in the selection unit (col. 5, lines 43-55).

8. Regarding claim 3, in accordance with claim 1, Bhatia discloses the method for setting up a connection via an IP-oriented network, the method further comprising the steps of:

initializing a connection setup by a first application running on the device (col. 5, lines 40-46 and col. 11, lines 43-53); and

transferring the information originating from a second application running on any given device to the router device (col. 5, lines 40-46 and col. 11, lines 43-53).

9. Regarding claim 4, in accordance with claim 3, Bhatia discloses the method for setting up a connection via an IP-oriented network, wherein the information is transferred via a separate connection via the local computer network (col. 4, lines 45-51).

10. Regarding claim 5, in accordance with claim 1, Bhatia discloses the method for setting up a connection via an IP-oriented network, the method further comprising the step of:

transmitting automatically, via the selection unit, a request message to the device which is transmitting the information in cases where no information is received in the selection unit (col. 4, line 66 – col. 5, line 4).

11. Regarding claim 7, in accordance with claim 1, Bhatia discloses the method for setting up a connection via an IP-oriented network, the method further comprising the step of:

automatically clearing down an existing communications connection between the device and a different conversion device at an end of a definable time period in cases

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where a new communications connection is set up between the device and a conversion device (col. 34, lines 58-65).

12. Regarding claim 9, in accordance with claim 1, Bhatia discloses the method for setting up a connection via an IP-oriented network, the method further comprising the steps of:

designing the selection unit according to a Domain Name Service proxy, wherein a Domain Name Service enquiry transferred from the device to the selection unit is checked to ascertain whether an Internet name corresponding to the Domain Name Service enquiry and identifying a conversion device is stored in the selection unit (col. 6, lines 9-14); and

forwarding the Domain Name Service enquiry, if the internet name is stored in the selection unit, via the communications network to the conversion device identified by the Internet name (col. 6, lines 25-33).

13. Regarding claim 10, in accordance with claim 2, Bhatia discloses the method for setting up a connection via an IP-oriented network, wherein the transferred information is an IP address (col. 5, lines 16-17) and, when an IP address specifically set up in the selection unit and identifying a conversion device is transferred, the corresponding conversion device is re-configured as the default conversion device (col. 5, lines 17-26).

14. Regarding claim 11, in accordance with claim 10, Bhatia discloses the method for setting up a connection via an IP-oriented network, the method further comprising the step of:

routing IP addresses subsequently transferred from a device to the router device via the currently set up default conversion device until a new IP address specifically set up in the selection unit is transferred to the router device (col. 12, lines 7-16).

15. Regarding claim 13, in accordance with claim 12, Bhatia discloses the router device wherein the selection unit is a server, a separate socket connection being provided between the device and the selection unit for transferring the information (col. 4, lines 64-66).

16. Regarding claim 14, in accordance with claim 12, Bhatia discloses the router device wherein the selection unit is designed according a Domain Name Service proxy (col. 5, line 66 – col. 6, line 8).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

19. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bhatia in view of Guerin et al. (U.S. 6,243,754), hereinafter referred to as Guerin.

20. Regarding claim 6, Bhatia discloses the use of a default conversion device as mentioned above, but is silent on the method of configuring the selection unit as a function of time of day. However, in related art, Guerin discloses the common use of a router that determines an appropriate conversion device based on a performance or a cost characteristic, one of the cost characteristics being a function of the time of day (see Guerin, col. 3, lines 9-20). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to utilize the time of day function cost characteristic as disclosed by Guerin in combination with the conversion device method as disclosed by Bhatia. One of ordinary skill in the art would have been motivated to make such a combination in order to ensure the proper conversion device is selected appropriately (see Guerin, col. 3, lines 7-30, specifically lines 11-14).

21. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bhatia.

22. Regarding claim 8, Bhatia is silent on the method to clear down a different device connected to the local computer network when a conversion device terminates another connection, however, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to utilize this method because it is reasonable to not terminate an active connection based on a separate entity's inactivity (see Bhatia, col. 16, lines 44-54).

23. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bhatia in view of Duvall et al. (U.S. 5,884,033), hereinafter referred to as Duvall.

24. Regarding claim 15, Bhatia discloses the use of a router but is silent on the use of an IP address filter. However, Duvall discloses a filtering system used in order to ALLOW or BLOCK incoming or outgoing transmissions (col. 4, lines 22-36). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to utilize the IP address filter as disclosed by Duvall in combination with the router device disclosed by Bhatia. One of ordinary skill in the art would have been motivated to make such a combination in order to control the flow of incoming and outgoing packets through the router and have the ability to block transmissions when it is deemed necessary to do so (see Duvall, col. 4, lines 22-36).

Response to Arguments

25. Applicant's arguments filed 08 September 2005 have been fully considered but they are not persuasive.

26. (A) Applicant argues on the first page of REMARKS and the 6th page of the Applicant's response: "...the cited art, alone or in combination does not teach or suggest 'selecting one of the conversion devices by said device, via a selection unit implemented in the router device, using information transferred by the device, wherein the information identifies the selected one of the conversion devices; and setting up a communications link to the select conversion device via the communications network.'"

27. In response to argument (A), the Examiner disagrees. Bhatia clearly discloses in column 11 line 59 – column 12 line 34 a user workstation connecting to a LAN modem

(which acts as a router for the Local Area Network). When the user workstation connections to the LAN modem, the user workstation provides information in regards to the ISP to which they are to be connected to ("selecting one of the conversion devices by said device). The LAN modem, using the information provided by the workstation, connects the user workstation to the appropriate ISP through the LAN modem ("a selection unit implemented in the router device, using information transferred by the device, wherein the information identifies the selected one of the conversion devices; and setting up a communications link to the select conversion device via the communications network."). In conclusion, it is deemed that Bhatia clearly discloses a method of having a user workstation that is connected to a Local area network being given the ability to access their own ISP via a method of providing necessary information and credentials to a router, the router providing the connection necessary between a user workstation and a conversion device (an ISP).

28. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "information may be transmitted to the router device by an arbitrary device connected to the local computer network") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin A. Ailes whose telephone number is (571)272-3899. The examiner can normally be reached on M-F 6:30-4, IFP Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

baa

A handwritten signature in black ink, appearing to read "Andrew Caldwell", with a stylized flourish at the end.

**ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER**